Paper 18

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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CHERYL DAVEY and
LAWRENCE T. MALEK

Junior Party,
(Patent 5,554,517),

v.

JAMES L. BURG,
PHILIPPE J. POULETTY, and JOHN C. BOOTHROYD

Senior Party,
(Application 08/427,606).

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Patent Interference No. 104,438

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Before McKELVEY, Senior Administrative Patent Judge and SCHAFER and GARDNER-LANE, Administrative Patent Judges.

GARDNER-LANE, Administrative Patent Judge.

FINAL JUDGMENT

The parties have filed a joint preliminary motion seeking an order terminating the interference on the basis that there

is no interference-in-fact (Paper 16). We GRANT the preliminary motion and enter final judgment.

A. Findings of fact

The record supports, by a preponderance of the evidence, the following findings, as well as any findings set out in the discussion portion of this ORDER.

1. The count of the interference is the process defined by claim 1 of the Davey patent (US 5,554,517 ("'517")) or the process defined by claim 1 of the Burg application (08/427,606 ("606")(Paper 1 at 5).

2. The Davey patent contains claims 1-15.

3. The Burg application contains claims 1-3 and 11-63.

4. Davey claims 1-5, 8, and 11-15 are designated as corresponding to the count (Paper 1 at 5).

5. All of the Burg claims are designated as corresponding to the count (Paper 1 at 5).

6. The process of Davey claim 1 and the process of Burg claim 1 appear to be the same except that the process of Davey claim 1 requires that the process defined therein be undertaken "at a relatively constant temperature and without serial addition of reagents" ('517 at claim 1).

7. Davey claims 2 to 10 depend, either directly or

indirectly, on Davey claim 1 and thus also require that the process they define be undertaken "at a relatively constant temperature and without serial addition of reagents" ('517 at claims 2 to 10).

8. The process of Davey claim 11 and the process of Burg claim 1 appear to be the same. The process of Davey patent claim 11 does not require that the process defined therein be undertaken "at a relatively constant temperature and without serial addition of reagents" ('517 at claim 11).

9. Davey patent claims 12-15 depend from Davey claim 11.

10. None of Davey claims 12-14 require that the process of claim 11 be undertaken "at a relatively constant temperature and without serial addition of reagents" ('517 at claims 12-14).

11. Davey claim 15 requires that the process of claim 11 be undertaken "at a relatively constant temperature and without serial addition of reagents" ('517 at claim 15).

12. According to Davey and Burg, none of the Burg application claims require that the process defined by the claims be undertaken "at a relatively constant temperature and without serial addition of reagents" (Paper 16 at 3).

13. Davey has disclaimed its claims 11 to 14 (Paper 17).

14. Accordingly, all the remaining Davey claims are directed to processes that must be undertaken "at a relatively constant temperature and without serial addition of reagents."

15. According to Davey and Burg, the remaining Davey claims are patentably distinct from the Burg claims.

16. In particular, Davey and Burg argue that (Paper 16 at 3):

> The USPTO has not cited any prior art indicating that the novel approach of Davey in its claims 1-5, 8 and 15, would have been obvious over the Burg claims. The claims call for adding reagents with many activities. It would not have been obvious to the person of ordinary skill in the art that all of these reagents could be added at the beginning of the process with no serial addition of reagents during the course of the entire process. Furthermore, it has not been shown that it would have been obvious that this mixture of reagents and material would react effectively and without undesirable cross reactions to give amplification at a relatively constant temperature without any substantial temperature change during the entire process. Thus, there is absolutely no basis for a suggestion that the Davey claim is obvious in view of the Burg claim.

17. In a statement submitted by the examiner (attached to Paper 1), there is no prior art cited to explain why it

would have been obvious to undertake the process described by the Davey and Burg claims "at a relatively constant temperature and without serial addition of reagents."

B. Discussion

An interference-in-fact exists when at least one claim of a party that is designated to correspond to a count and at least one claim of an opponent that is designated to correspond to the count define the same patentable invention. 37 CFR § 1.601(j). Invention "A" is the same patentable invention as an invention "B" when invention "A" is the same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a separate patentable invention with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and
non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". 37 CFR § 1.601(n). "Resolution of an interference-in-fact issue involves a two-way patentability analysis." Winter v. Fujita,
53 USPQ2d 1234, 1243 (BPAI 1999).

In the present circumstances, it was appropriate to declare the interference since claim 11 of Davey and claim 1

of Burg appear to be the same as (35 USC 102) or obvious (35 USC 103) in view of each other. However, since Davey has disclaimed its claim 11 (along with dependent claims 12 to 14), it does not appear that at least one claim of Davey and at least one claim of Burg define the same patentable invention. All the remaining Davey claims contain the limitation that the process defined therein be undertaken at "at a relatively constant temperature and without serial addition of reagents." No Burg claim contains this limitation. There is insufficient evidence of record to establish that one skilled in the art would have found it obvious to modify any Burg claim to require that the process defined in the claim be undertaken "at a relatively constant temperature and without serial addition of reagents."

Accordingly, a judgment of no interference-in-fact is appropriate.

C. Order

It is

ORDERED that joint preliminary motion 1 (Paper 16) is GRANTED;

FURTHER ORDERED that, there being no interference-in-fact, judgment on priority as to Count 1, the sole count in the interference, is awarded in favor of junior party CHERYL DAVEY and LAWRENCE T. MALEK and senior party JAMES L. BURG, PHILIPPE J. POULETTY, and JOHN C. BOOTHROYD;

FURTHER ORDERED that junior party CHERYL DAVEY and LAWRENCE T. MALEK, is not entitled to a patent containing disclaimed claims 11 to 14 of U.S. Patent 5,554,517;

FURTHER ORDERED that, on the record before us, junior party CHERYL DAVEY and LAWRENCE T. MALEK, is entitled to a patent containing claims 1-5, 8, and 15 of U.S. Patent 5,554,517, which correspond to Count 1 and senior party JAMES L. BURG, PHILIPPE J. POULETTY, and JOHN C. BOOTHROYD is entitled to a patent containing claims 1-3 and 11-63 of U.S. application 08/427,606, which correspond to count 1;

FURTHER ORDERED that a copy of Paper 17 filed by Davey and disclaiming claims 11 to 14 (copy attached) be entered in the administrative record of Davey's 5,554,517 patent;

FURTHER ORDERED that if there is a settlement agreement, the parties are directed to 35 USC § 135(c) and 37 CFR § 1.666;

FURTHER ORDERED that a copy of this decision be given a paper number and be entered in the administrative records of Davey's 5,554,517 patent and Burg's 08/427,606 application.

FRED E. McKELVEY, Senior Administrative Patent Judge	)
CAROL A. SPIEGEL Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
SALLY GARDNER-LANE Administrative Patent Judge	)

Enc:
Copy of Paper 17 entitled "SUBMISSION OF DISCLAIMER UNDER 37 CFR 1.321(a)"

cc (via facsimile and first class mail):

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